REMARKS

In the Office Action, the Examiner rejected claims 1-27 under 35 USC § 102(e). This rejection is fully traversed below.

Claims 1, 11, 13 and 20 have been amended to further clarify the subject matter regarded as the invention. Withdrawn claims 28-30 have been cancelled. New claims 31-33 have also been added to the application. Thus, claims 1-27 and 31-33 are pending in the application. Reconsideration of the application is respectfully requested based on the following remarks.

REJECTION OF CLAIMS 1-27 UNDER 35 USC § 103

In the Office Action, the Examiner rejected claims 1-27 under 35 USC § 102(e) as being unpatentable over <u>Schneider</u>, U.S. Patent No. 6,338,082. Applicants respectfully disagree.

Schneider describes a method, product and apparatus for requesting a network resource. According to Schneider, "[w]hen a network resource request having a domain name is received, it is determined whether the network resource can be located including determining whether the domain name is resolvable. Rather than displaying an error message or processing a search request in response to determining that a network resource can not be located or of an unresolvable domain name, the domain name can instead be redirected to a registration service where the unresolvable domain name is automatically used to perform a registration request and determine domain name availability. When the domain name is not available for registration, domain name registrant information is provided. However, when the domain name is determined available, a registration form is provided." See Abstract.

In contrast, claim 1 pertains to a computer-implemented method for monitoring domain name registrations. In particular, a request to monitor a name is received. Then, a database of domain name registrations can be searched to

identify one or more registrations of domain names that match the name being monitored. The requestor of the monitoring can then be notified of the identified one or more registrations. The searching and the modifying are periodically automatically performed so as to provide monitoring for domain name registrations that match the name being monitored.

On page 2 of the Office Action, the Examiner references Fig. 3a of Schneider and its discussion at column 12, line 57 through column 13, line 25. At block 314 of Fig. 3a, a determination of whether a domain name is available is made. If the domain name is already registered, then it is not available and a record from the WHOIS database is displayed. First of all, it should be noted that the processing illustrated in Fig. 3a is performed on user request after a user input has been provided. In contrast, claim 1 is periodically and automatically performed to provide monitoring function to identify domain name registrations that match the name being monitored. The processing in Fig. 3a of Schneider does not perform a monitoring process. Nor is the processing in Fig. 3a of Schneider periodically and automatically performed. Accordingly, it is submitted that claim 1 is patentably distinct from Schneider.

Claim 11, similar to claim 1, pertains to the computer-implemented method for monitoring domain name registrations. In monitoring domain name registrations, when one or more registrations are identified as matching a name being monitored, the method further operates to send warning messages to the offending registrants. In this regard, claim 11 recites: "sending warning messages to registrants of the identified one or more registrations." On page 4 of the Office Action, the Examiner points to block 318 of Fig. 3a which displays a record from the WHOIS database. More particularly, in response to a registration request, if the domain name 306 is determined not to be available in step 314, then a record from a corresponding WHOIS database is retrieved and displayed at step 318. Schneider, col. 12, lines 57-67. Schneider is merely notifying the user of the method in Fig. 3a that a domain name is not available. In contrast, claim 11 is sending warning messages to registrants associated with the one or more identified registrations, not the requestor who is inquiring as to the

availability of the domain name. Hence, it is submitted that claim 11 is patentably distinct from Schneider.

Still further, claim 13 pertains to a computer-implemented method for monitoring domain name registrations. The monitoring involves searching one or more registration databases to identify one or more registrations of domain names that are similar to a name being monitored. Again, like claim 1, the monitoring of domain name registrations is periodically automatically performed. Further, the searching identifies one or more registrations of domain names that are identical to, or variants of, then name to be monitored.

As to claim 26, on page 4 of the Office Action, the Examiner asserts that a WHOIS search for a domain name "has the effect of monitoring the activation of a website." Applicants respectfully disagree. A registration of a domain occurs when a person "buys" a domain name. For example, a user might buy a domain name "www.mydomainname.com". Once the domain name is bought, the user has to thereafter link the domain name to an IP address that contains the content for a website, e.g., HTML page(s) to be provided at that IP address. The recited act of "monitoring activation of a website at the domain names of the identified one or more registrations" serves to determine if there has been established a website at the IP address for the domain name. Hence, the purchase of a domain name does not mean that the user has established a website at the domain name.

Based on the foregoing, it is submitted that claims 1, 11, 13 and 26 are patentably distinct from Schneider. In addition, it is submitted that claims 2-10, 12, 14-25, 27 and 31-33 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Schneider.

As to new claims 31-33, claim 31 depends from claim 12 and therefore is patentably distinct from Schneider for at least the same reasons as noted above

for claim 11 since claim 12 depends from claim 11. Claim 31 also recites "wherein said receiving (a) comprises receiving monitoring request data from a requestor, the monitoring request data being provided through interaction with a web site accessible via the Internet." Schneider also fails to teach or suggest receiving a monitoring request data being provided through interaction with a web site accessible via the Internet as recited in claim 31. Claims 32 and 33 depend from claim 31 and are therefore patentably distinct from Schneider for at least the same reasons as claim 31.
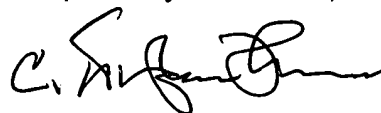
Thus, it is respectfully requested that the Examiner withdraw the rejection of the claims under 35 USC § 102(e).

SUMMARY

It is submitted that claims 1-27 (and new claims 31-33) are patentably distinct from Schneider. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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